

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY



(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

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Applicant's or agent's file reference 59049WO003	FOR FURTHER ACTION See Form PCT/IPEA/416	
International application No. PCT/US2004/032033	International filing date (day/month/year) 30.09.2004	Priority date (day/month/year) 30.09.2003
International Patent Classification (IPC) or national classification and IPC B65H37/04		
Applicant 3M INNOVATIVE PROPERTIES COMPANY et al.		
<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 7 sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input checked="" type="checkbox"/> sent to the applicant and to the International Bureau) a total of 5 sheets, as follows:</p> <p><input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) , containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>		
<p>4. This report contains indications relating to the following items:</p> <p><input checked="" type="checkbox"/> Box No. I Basis of the opinion</p> <p><input type="checkbox"/> Box No. II Priority</p> <p><input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p><input type="checkbox"/> Box No. IV Lack of unity of invention</p> <p><input checked="" type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input type="checkbox"/> Box No. VIII Certain observations on the international application</p>		
Date of submission of the demand 09.06.2005	Date of completion of this report 19.12.2005	
Name and mailing address of the international preliminary examining authority:  European Patent Office - P.B. 5818 Patentlaan 2 NL-2280 HV Rijswijk - Pays Bas Tel. +31 70 340 - 2040 Tx: 31 651 epo nl Fax: +31 70 340 - 3016	Authorized Officer Raven, P Telephone No. +31 70 340-3287 	

**INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY**

International application No.
PCT/US2004/032033

Box No. I Basis of the report

1. With regard to the **language**, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language , which is the language of a translation furnished for the purposes of:
- ☐ international search (under Rules 12.3 and 23.1(b))
 - ☐ publication of the international application (under Rule 12.4)
 - ☐ international preliminary examination (under Rules 55.2 and/or 55.3)
2. With regard to the **elements*** of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report):*

Description, Pages

1-16 as originally filed

Claims, Numbers

1-20 filed with telefax on 09.06.2005

Drawings, Sheets

1/13-13/13 as originally filed

☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing

3. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages
- ☐ the claims, Nos.
- ☐ the drawings, sheets/figs
- ☐ the sequence listing (*specify*):
- ☐ any table(s) related to sequence listing (*specify*):

4. ☒ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

- ☐ the description, pages
- ☒ the claims, Nos. 1,12
- ☐ the drawings, sheets/figs
- ☐ the sequence listing (*specify*):
- ☐ any table(s) related to sequence listing (*specify*):

* If item 4 applies, some or all of these sheets may be marked "superseded."

**INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY**

International application No.
PCT/US2004/032033

Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	1-11,14-17,19
	No: Claims	12,13,18,20
Inventive step (IS)	Yes: Claims	1-11,14-17,19
	No: Claims	12,13,18,20
Industrial applicability (IA)	Yes: Claims	1-20
	No: Claims	

2. Citations and explanations (Rule 70.7):

see separate sheet

Re Item I

1. The amendments filed with the fax dated 06.09.2005 introduce subject-matter which extends beyond the content of the application as filed, contrary to Article 34(2)(b) PCT. The amendments concerned are the following:
 - 1.1. In claims 1 and 12, the term 'pivotably' has been removed from the feature 'an application structure *pivotably* coupled to said directing structure'. Since the originally filed description, claims and figures clearly indicate that the application structure is pivotably connected to the directing structure and because no other coupling arrangement is suggested or hinted at, the removal of this term constitutes a broadening of the subject-matter of the claims beyond that of the application as filed.
 - 1.2. In claim 12, The term 'rotatable' has been removed from the phrase 'at least one *rotatable* element for applying the adhesive-backed film.....relative to said *rotatable* element and said first surface'. Since the originally filed description, claims and figures clearly indicate that the application element is rotatable (being a roller 37 in all embodiments) and because no other form of application element is suggested or hinted at, the removal of this term constitutes a broadening of the subject-matter of the claims beyond that of the application as filed.

Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Reference is made to the following document:
D1: WO 03/062109 A (3M INNOVATIVE PROPERTIES COMPANY) 31 July 2003
(2003-07-31)
2. **Independent claim 1.**

Document D1, which is considered to represent the most relevant state of the art, discloses an adhesive-backed film application tool for applying an adhesive-backed film to a first surface of an adherend from which the subject-matter of claim 1 differs

in that said tool is provided with a structure for releasably coupling a movable guide surface in a first position.

The subject-matter of claim 1 is therefore new (Article 33(2) PCT).

- 2.1. The movable guide surface (23) of D1 has only the biasing spring (26) to act as locating means in the first position. The movable guide surface is therefore allowed to 'float' against the action of the spring. The problem to be solved by the present invention may therefore be regarded as providing for a more stable application of the adhesive-backed film to the adherend in the first position.

The solution to this problem proposed in the final feature of claim 1 of the present application is considered as involving an inventive step (Article 33(3) PCT) since it is neither known from, nor made obvious by, the disclosure of the known state of the art.

- 2.2. Claims 2-11 are dependent on claim 1 and as such also meet the requirements of the PCT with respect to novelty and inventive step.

3. Independent claim 12.

- 3.1. The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claim 12 is not new in the sense of Article 33(2) PCT.

The document D1 discloses (the references in parentheses applying to this document):

an adhesive-backed film application tool (50) for applying an adhesive-backed film having at least first and second widths to a first surface of an adherend (45), said adherend (45) further including a second surface, said tool (50) comprising: a directing structure (6,7) adapted to engage said second surface of said adherend; an application structure *pivotably* coupled to said directing structure; an element (31) for biasing said directing and application structures toward one another such that said directing and application structures are capable of being releasably clamped to said

adherend; and said application structure including at least one *rotatable* element (9) for applying the adhesive-backed film to said first surface and guide structure (23) for properly locating said adhesive-backed film relative to said *rotatable* element (9) and said first surface, said guide structure (23) having a manually movable guide surface capable of being located in a first position corresponding to said first width of said adhesive-backed film and a second position corresponding to a second width of said adhesive-backed film.

As can be seen from the above, document D1 discloses in combination all the features defined in independent claim 12. Hence the subject-matter of this claim is not new (Article 33(2) PCT). It should be noted that whilst the movable guide surface of D1 is not explicitly described as being moved manually it appears to be capable of being moved manually and therefore this feature is anticipated by D1.

- 3.2. Dependent claim 13 does not contain any features which, in combination with the features of claim 12, meet the requirements of the PCT in respect of novelty or inventive step.
- 3.3. The combination of the features of dependent claims 14-17 is neither known from, nor rendered obvious by, the available prior art.
4. **Independent claim 18.**
 - 4.1. The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claim 18 is not new in the sense of Article 33(2) PCT.

The document D1 discloses (the references in parentheses applying to this document):

a process for applying an adhesive-backed film having a first section with a first width and a second section with a second width to a first surface of a sash (45), said process comprising the steps of; clamping an adhesive-backed film application tool (50) to the sash; applying the adhesive-backed film to the first surface of the sash via at least one rotatable element (9) of said tool, said tool including a movable guide

plate including a movable guide surface capable of being located in a first position corresponding to a first width of said adhesive-backed film and a second position corresponding to a second width of said adhesive-backed film; and moving said movable guide surface to said second position when a section of said guide plate engages a corner of said sash, said movable guide surface being moved to said second position approximately when said second section of said adhesive-backed film is to be applied to said sash first surface.

- 4.2. Document D1 states on page 2, lines 11-14 that the object of the disclosure concerns the attachment of an adhesive tape to an adherend having bent sections along its length. Since the guide structure (23) of the application tool is arranged to move when the width of the adherend increases, it is understood that such a movement will take place when the application tool encounters a corner in the adherend surface. Therefore, document D1 discloses in combination all the features defined in independent claim 18. Hence the subject-matter of this claim is not new (Article 33(2) PCT).
- 4.3. Dependent claim 20 does not contain any features which, in combination with the features of claim 18, meet the requirements of the PCT in respect of novelty or inventive step.
- 4.4. The combination of the features of dependent claim 19 is neither known from, nor rendered obvious by, the available prior art.

We Claim:

1. **An adhesive-backed film application tool for applying an adhesive-backed film to a first surface of an adherend, said adherend further including a second surface, said tool comprising:
a directing structure adapted to engage said second surface of said adherend;
an application structure coupled to said directing structure;
an element for biasing said directing and application structures toward one another such that said directing and application structures are capable of being releasably clamped to said adherend;
said application structure including at least one element for applying the adhesive-backed film to said first surface and guide structure for properly locating said adhesive-backed film relative to said applying element and said first surface, said guide structure having a movable guide surface capable of being located in a first position corresponding to a first dimension of said adhesive-backed film and a second position corresponding to a second dimension of said adhesive-backed film; and
structure for releasably coupling said movable guide surface in said first position.**
2. **An adhesive-backed film application tool as set forth in claim 1, wherein said application structure further includes a main body.**
3. **An adhesive-backed film application tool as set forth in claim 2, wherein said guide structure comprising a guide assembly which is movable relative to said main body, said guide assembly comprising a guide plate having a surface defining said movable guide surface.**
4. **An adhesive-backed film application tool as set forth in claim 3, wherein said guide assembly further comprises an element for biasing said guide surface toward said second position.**
5. **An adhesive-backed film application tool as set forth in claim 4, wherein said guide assembly further comprises:**

an engagement bar;
at least one slide rod passing through a bore in said main body and being fixedly coupled to said engagement bar and said guide plate; and
a spring defining said biasing element, engaging said engagement bar and biasing said engagement bar and said guide plate to a second location such that said movable guide surface is located in said second position.

6. An adhesive-backed film application tool as set forth in claim 5, wherein said directing structure comprises a lever which is capable of engaging said engagement bar to move said engagement bar against said spring such that said engagement bar and said guide plate are moved to a first location where said movable guide surface is located in said first position.

7. An adhesive-backed film application tool as set forth in claim 5, wherein said releasably coupling structure comprises a first magnetic element and a second magnetic element, said first and second magnetic elements releasably coupling said engagement bar to said main body when said engagement bar and said guide plate are moved to a first location.

8. An adhesive-backed film application tool as set forth in claim 7, wherein said guide plate comprises a section which engages a portion of said adherend approximately where said first surface of said adherend changes widths, said adherend portion causing said guide plate to move toward said main body while said engagement bar moves away from said main body such that said first and second magnetic elements are separated sufficiently to allow said spring to move said engagement bar and said guide plate to said second location.

9. An adhesive-backed film application tool as set forth in claim 5, wherein said releasably coupling structure comprises a first connector element and a second connector element, said second connector element being releasably engageable with said first connector element so as to releasably couple said engagement bar to said main body when said engagement bar and said guide plate are moved to a first location.

10. An adhesive-backed film application tool as set forth in claim 3, wherein said guide structure further comprises a lower guide plate which is spaced from and fixed in position relative to said main body, said lower guide plate having a surface defining a fixed guide surface which is spaced from said movable guide surface by a distance substantially equal to said first dimension when said movable guide surface is located in said first position and is spaced from said movable guide surface by a distance substantially equal to said second dimension when said movable guide surface is located in said second position.

11. An adhesive-backed film application tool as set forth in claim 10, wherein said guide structure further comprises an outer guide which is spaced from said at least one applying element so as to define a gap for receiving said adhesive-backed film and an accompanying release liner.

12. An adhesive-backed film application tool for applying an adhesive-backed film having at least first and second widths to a first surface of an adherend, said adherend further including a second surface, said tool comprising:

a directing structure adapted to engage said second surface of said adherend;

an application structure coupled to said directing structure;

an element for biasing said directing and application structures toward one another such that said directing and application structures are capable of being releasably clamped to said adherend; and

said application structure including at least one element for applying the adhesive-backed film to said first surface and guide structure for properly locating said adhesive-backed film relative to said element and said first surface, said guide structure having a manually movable guide surface capable of being located in a first position corresponding to said first width of said adhesive-backed film and a second position corresponding to said second width of said adhesive-backed film.

13. An adhesive-backed film application tool as set forth in claim 12, wherein said application structure further includes a main body.

14. An adhesive-backed film application tool as set forth in claim 13, wherein said guide structure comprising a guide assembly which is movable relative to said main body, said guide assembly comprising a guide plate having a surface defining said movable guide surface, and an element biasing said guide surface toward said second position.

15. An adhesive-backed film application tool as set forth in claim 14, wherein said guide assembly further comprises:

an engagement bar;

at least one slide rod passing through a bore in said main body and being fixedly coupled to said engagement bar and said guide plate; and

a spring defining said biasing element, engaging said engagement bar and biasing said engagement bar and said guide plate to a second location such that said movable guide surface is located in said second position.

16. An adhesive-backed film application tool as set forth in claim 15, wherein said engagement bar is capable of being manually engaged to move said engagement bar against said spring such that said engagement bar and said guide plate are moved to a first location where said movable guide surface is located in said first position.

17. An adhesive-backed film application tool as set forth in claim 12, wherein said guide surface is manually movable to said first position.

18. A process for applying an adhesive-backed film having a first section with a first width and a second section with a second width to a first surface of a sash, said process comprising the steps of:

clamping an adhesive-backed film application tool to the sash;

applying the adhesive-backed film to the first surface of the sash via at least one rotatable element of said tool, said tool including a movable guide plate including a movable guide surface capable of being located in a first position corresponding to said first width of said adhesive-

backed film and a second position corresponding to said second width of said adhesive-backed film; and

moving said movable guide surface to said second position when a section of said guide plate engages a corner of said sash, said movable guide surface being moved to said second position approximately when said second section of said adhesive-backed film is to be applied to said sash first surface.

19. A process as set forth in claim 18, wherein said guide surface is biased toward said second position.

20. A process as set forth in claim 18, wherein said moving step is conducted automatically.